Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. SEGATTA, PAUL H. SANDSTROM
and SHAHUR R. AZER

Appeal No. 1998-2277
Application No. 08/353,942

ON BRIEF

Before PAK, DELMENDO, and JEFFREY T. SMITH, ***Administrative Patent Judges***.

JEFFREY T. SMITH, ***Administrative Patent Judge.***

DECISION ON APPEAL

Applicants appeal the decision of the Primary Examiner finally rejecting claims 1, 2, 4, 5, 6 and 8 to 14, all of the claims in the application. Because the issues are not ripe for appeal, we remand.

The Examiner has entered the following rejections:

Claims 1, 2, 4, 5, 6 and 8 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sandstrom (US 5,174,838) in view of EP 0,410,311, EP 0,461,329, JP 1-135847.

Claims 1, 2, 4, 5, 6 and 8 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda (US 4,824,899) in view of Sandstrom (US 5,174,838).

Claims 1, 2, 4, 5, 6 and 8 to 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57-212239 in view of Sandstrom (US 5,174,838).

DISCUSSION

Appellants supplied a declaration as an attachment to the Brief filed June, 2, 1997. Appellants state the declaration will be referred to by respective passages of the Brief. (Brief, p. 3.) In fact, Appellants when addressing several of the above rejections, refer to this declaration. (For example, see Brief pages 4, 5 and 8.) However, the Examiner has not addressed the sufficiency of the declaration.

We also note the prior art cited in the Answer includes published foreign language applications and/or patents. The statements of the rejections in the Answer indicate that the rejections are based on, *inter alia*, these foreign language applications and/or patents.[1]

[1] The statement of the rejections did not refer to the abstract document accession number. Rather, the rejection referenced the underlying EP 0,410,311, EP 0,461,329, JP 1-135847 and JP 57-212239 documents.

However, when discussing the rejections, the Examiner refers to the abstracts of EP 0,410,311, JP 1-135847 and JP 57-212239.[2] Translations of these documents were provided with the Answer.[3] Since the Examiner has for the first time presented (i.e., with the Answer) the corresponding English language translations of the cited foreign language documents, upon return of this application, the Examiner needs to reevaluate the relevance of the declaration in view of these newly presented English language translations.

The board serves as a board of review, not a *de novo* examination tribunal. See 35 U.S.C. § 6(b) ("The [board] shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents."). The burden is on the Examiner to set forth a ***prima facie*** case of obviousness. ***See In re Alton,*** 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Findings of fact and conclusions of law must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). ***See Zurko v. Dickinson,*** 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be

[2] We observe that only English language abstracts were of record at the time the Final Rejection was made.

[3] We also note none of these translations contain an abstract.

supported by substantial evidence within the record. ***See In re Gartside,*** 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

The Examiner has entered three rejections under 35 U.S.C. §103(a) relying on various combinations of Sandstrom (US 5,174,838), EP 0,410,311, EP 0,461,329, JP 1-135847, JP 57-212239 and Yasuda (US 4,824,899). The Examiner has failed to indicate which portions of the EP 0,410,311, EP 0,461,329, JP 1-135847, JP 57-212239 and Yasuda (US 4,824,899) references are being relied upon as teaching or suggesting the claimed invention. See 37 CFR § 1.104(b)(2).

As stated in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**.... (emphasis added).

The Board is required by the Federal Circuit to analyze the claims on a limitation-by-limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings. ***Gechter v. Davidson,*** 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997). The Examiner must meet an equivalent standard, because the Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000). The Examiner must specifically

identify the teachings in the applied prior art corresponding to the specific limitations in the claims on appeal and indicate why it would have been obvious to incorporate the claimed features not specifically taught in the applied prior art.

Upon return of this application, it is ordered that the Examiner:

1) shall consider the declaration, attached to the Brief, and shall determine whether the declaration affects the patentability of the claimed subject matter; and

2) shall indicate where and how each and every claim limitation is taught or suggested in the applied prior art references.

If any reliance on the English translations corresponding to the cited foreign documents constitutes new grounds of rejection, the Examiner should reopen the prosecution of this application.

This application, by virtue of its "special" status requires an immediate action. *MPEP* § 708.01(d) (7th ed., Rev. 1, Feb. 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

REMANDED

CHUNG K. PAK
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

JTS/gjh

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